Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte STEFAN MAIER,
JOACHIM STILLING,
and FRANK SCHINDLER

Appeal No. 1999-0869
Application 08/644,608[1]

ON BRIEF

Before HAIRSTON, BARRETT, and RUGGIERO, Administrative Patent Judges.

BARRETT, Administrative Patent Judge.

[1] Application for patent filed April 26, 1996, entitled "Method For Measuring The Lift Of A Valve Needle Of A Valve And For Adjusting The Volume Of Media Flow Of The Valve," which is a continuation of Application 08/300,835, now abandoned, which claims the foreign filing priority benefit under 35 U.S.C. § 119 of German Application P 43 29 976.8, filed September 4, 1993.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the final rejection of claims 1-13.

We reverse.

BACKGROUND

The disclosed invention is directed to a method for measuring the lift of a valve needle using a laser. The setpoint values for the lift of the valve needle correspond to precisely known, specified volumes of media flow to be delivered.

No prior art is relied on in the rejection.

The specification is objected to, and claims 1-13 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to provide an adequate written description of the invention and failing to adequately teach how to make and/or use the invention. The Examiner states that the specification shows generation of laser light but fails to disclose a light detector. Further, the Examiner states, it is not disclosed how the detected radiation would be manipulated to determine axial distance and "[a] person with ordinary skill in the art would have to guess on the type of detector and the process of manipulating the data in order to make and/or use the invention" (Examiner's Answer, p. 4).

We refer to the Final Rejection (Paper No. 13) and the Examiner's Answer (Paper No. 16) (referred to as "EA__") for a

statement of the Examiner's position, and to the Brief (Paper No. 15) (pages referred to as "Br__") and the Reply Brief (Paper No. 17) for a statement of Appellants' arguments thereagainst.

OPINION

Written description

The written description rejection under 35 U.S.C. § 112, first paragraph, is used to reject when a claim is amended to recite elements thought to be without support in the original disclosure. In re Rasmussen, 650 F.2d 1212, 1214-15, 211 USPQ 323, 326 (CCPA 1981). "Satisfaction of the description requirement insures that subject matter presented in the form of a claim subsequent to the filing date of the application was sufficiently disclosed at the time of filing so that the prima facie date of invention can fairly be held to be the filing date of the application." Vas-Cath, Inc. v. Mahurkar, 935 F.2d 1555, 1562, 19 UPSQ2d 1111, 1115 (Fed. Cir. 1991), citing In re Smith, 481 F.2d 910, 914, 178 USPQ 620, 623 (CCPA 1973). Written description is a question of fact. Vas-Cath, 935 F.2d at 1563, 19 USPQ2d at 1116.

The Examiner does not reject the claims on the basis that a limitation added by amendment is without support in the original disclosure. In fact, the original claims have not been amended. Accordingly, the written description rejection is not proper. The rejection of claims 1-13 under the written description requirement of § 112, first paragraph, is reversed.

Enablement

"The test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation." United States v. Telectronics, Inc., 857 F.2d 778, 785, 8 USPQ2d 1217, 1223 (Fed. Cir. 1988), citing Hybritech, Inc. v. Monoclonal Antibodies, Inc., 802 F.2d 1367, 1384, 231 USPQ 81, 94 (Fed. Cir. 1986). Patents are written to be read by those having ordinary skill in the art and a patent need not teach, and preferably omits, what is well known in the art. Paperless Accounting, Inc. v. Bay Area Rapid Transit System, 804 F.2d 659, 664, 231 USPQ 649, 652 (Fed. Cir. 1986). The U.S. Patent and Trademark Office must support a rejection for lack of enablement with reasons. In re Marzocchi, 439 F.2d 220, 223-24, 169 USPQ 367, 369-70 (CCPA 1971). Enablement is a question of law, which may involve subsidiary questions of fact. Paperless Accounting, 804 F.2d at 664, 231 USPQ at 652.

We find ourselves in agreement with Appellants' arguments in the Brief and Reply Brief that the subject matter of

claims 1-13 is enabled. As noted by appellants (Br4), figures 2 and 3 disclose that the laser system 71 generates and detects light because the laser beams (70a and 70b in figure 2; 70c in figure 3) have arrows in both directions, toward and away from the laser system 71. The specification discloses measuring the valve needle lift with a laser system (e.g., specification, p. 2, lines 20-25). In particular, original claim 1, which is part of the disclosure, recites "measuring an axial range of motion . . . by detecting the radiation." It would have been manifestly apparent to one of ordinary skill in the art that "detecting the radiation" must be done with a detector appropriately placed to measure the reflected radiation. Accordingly, we find the Examiner erred in stating that "Appellant has made no reference to the detection of light in the specification" (EA3).

As to the Examiner's position that it is unclear how the detected radiation would be manipulated to determine lift of the valve needle, Appellants argue that laser systems to sense position by reflected light were well known to one of ordinary skill in the art at the time of filing and, hence, did not need to be disclosed in detail (Br7-8). It is the Examiner's

burden to provide evidence or convincing reasons why a laser measurement system was not enabling. The Examiner has merely questioned how the measurement is done, and stated that how the measurement is done is not known to the Examiner rather than by one skilled in the art, which we feel does not satisfy the Examiner's burden. Nevertheless, Appellants provided the Examiner a copy and translation of "Dynamic Autofocus Sensor for Measuring Three-Dimensional Microstructures," tm-Technishes Messen 59 (1992) 1, R. Oldenbourg Publishing House, pp. 3-9 and Fig. 1. This reference proves that laser position measurement systems were known in the prior art. Manifestly, any laser measurement system could be used since this is not Appellants' invention. This is not a case where the elements were not known to exist in the prior art. Cf. In re Buchner, 929 F.2d 660, 18 USPQ2d 1331 (Fed. Cir. 1991) (no evidence that phase comparator having four inputs and one output and divider having two inputs and one output were known in the prior art). Accordingly, the Examiner erred in concluding that laser measurement systems were not conventional.

For the reasons stated above, we conclude that the Examiner has failed to establish a prima facie case of non-enablement. The rejection of claims 1-13 under the enablement requirement of § 112, first paragraph, is reversed.

CONCLUSION

The rejections of claims 1-13 are reversed.

REVERSED

KENNETH W. HAIRSTON Administrative Patent Judge	)
LEE E. BARRETT Administrative Patent Judge	) BOARD OF PATENT APPEALS AND INTERFERENCES
JOSEPH F. RUGGIERO Administrative Patent Judge	)

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